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Sun-Dong Lee

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H.C. PARK & ASSOCIATES, PLC
8500 LEESBURG PIKE
SUITE 7500
VIENNA, VA 22182

EXAMINER

CASCA, FRED A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/788,429	Applicant(s) LEE, SUN-DONG	
	Examiner Fred A. Casca	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on March 6, 2007. Claims 1-2, 4-14, and 18-26 are still pending in the present application. **This Action is made FINAL.**

Response to Arguments

2. Applicant's arguments filed on March 6, 2007 have been fully considered but they are not persuasive.

3. With respect to the rejection of claims 1-2, 4-14, and 18-26 under 35 U.S.C § 112, first paragraph, applicant argues that "The subject matter of the claim need not be described literally . . . in order for the discloser to satisfy the description requirement", "Applicant acknowledges that the term "real-time notification" (RTN) was not used in the specification, but respectfully submits that subject matter of RTN is fully supported by the specification as filed". The applicant further refers to page 13, lines 16-20, page 16, lines 3-6, and page 19, lines 20-22 of the specification and asserts that the contents of these portions of the specification renders the meaning of "real-time notification". The examiner disagrees and asserts "real-time" in computational sciences and engineering bears a specific meaning to a system. A system is said to be **real-time** if the correctness of an operation depends not only upon the logical correctness of the operation but also upon the time at which it is performed. Further, in an immediate real-time system, the completion of a nonsimultaneous operation is considered useless - ultimately, this may lead to a critical failure of the complete system. Furthermore, "real-time" is a very specific well-known phrase in engineering and the applicant has not specifically mentioned it in the specification. Thus, the rejection of claims 1-2, 4-14, and 18-26 under 35 U.S.C § 112, first paragraph is maintained.

4. Referring to claim 20, applicant's argument with respect to phrase "if a called subscriber has logged in to an incoming messenger alarming service on the personal computer" is persuasive. However, applicant's argument with respect to the phrase "real-time notification" is not persuasive. Thus, the rejection of claim 20 under 35 U.S.C § 112, first paragraph is maintained. Please see examiner arguments above with respect to the "real-time" above in paragraph 3.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references Nguyen (US 2002/0111167) and Troen-Krasnow (US 6493931) teach the art of messaging systems including messaging servers, mobile computing devices, and

notification to users in a telecommunication system. Troen-Krasnow teaches the additional feature of sending a phone message to a personal computer of a phone device, so that a user can obtain messages while being logged on to a computer, thus user convenience is a valid motivation.

7. In response to applicant's argument that references Nguyen (US 2002/0111167) and Troen-Krasnow (US 6493931) and Bose (US 200200428300 are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the laimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all three references teach the art of messaging system in telecommunications, Bose, specifically teaches "real-time messaging system".

8. With reference to claims 11 and 18, the applicant argues that the combo of Nguyen/Troen-Krasnow/Bose does not disclose "a messenger information database for storing an IP address and a messenger ID of a called subscriber". The examiner disagrees and asserts that Troen-Krasnow's sending notification to the called party's personal computer clearly teaches a message database for storing an IP address and a messenger ID of the called subscriber (Troen-Krasnow, col. 4, lines 50-67, col. 5, lines 1-35, "the message server 180 sends a notification to the called party that a call has been received ... the notification message ... transmitted to the called party's **personal computer**"). Note the phrase "**personal computer**" is

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a specific phrase mentioned by Troen-Krasnow. Further note that Troen-Krasnow specifically teaches that a notification is sent to the personal computer of the called party, where the call was directed to the called party's voice phone. Further note that any message sent to a personal computer requires the IP address of that personal computer. Therefore, it is inherent that the IP address of the personal computer is stored in database system of the messaging system. In response to argument that "Rather, an email message may be transmitted to a server accessible over a network and having an IP address that does not correspond to an IP address of the called party's personal computer", the examiner disagrees because Troen-Krasnow clearly and specifically mentions the phrase "personal computer", thus, although other options may be possible, the transmitting of message to a personal computer is a clear choice by Troen-Krasnow. Furthermore, the language of the claim is very broad, the phrase, "a messenger information database for storing an IP address and a messenger ID of a called subscriber" in lines 1-2 of claim 11 well-known and is taught in many forms of Internet communication, Voice over IP and messaging systems involving the Internet.

9. In response to argument that the combo of Nguyen/Troen-Krasnow/Bose does not disclose "a messenger server for sending a second notification message to a personal computer corresponding to the IP address", the examiner disagrees and asserts that Troen-Krasnow clearly shows a sending a notification to a personal computer of the called party when the call was originally initiated for a voice phone system of the called party (col. 4, lines 50-67, col. 5, lines 1-35). Note that Troen-Krasnow's notification is "a second notification message", and this "second notification message" doesn't have to be a repeat of a first notification message.

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10. Arguments with respect to claims 5-7 are persuasive. Thus the rejection of claims 5-7 under 35 USC § 103 is withdrawn.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-14 and 18-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 8, 11 18 and 20 have been amended to contain new matter. The phrase "real-time notification" has been added to independent claims 1, 8, 11, 18 and 20 has not been described in the specification.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-2, 4, 8-14, 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (U.S. Pub. No. 2002/0111167 A1), in view of Troen-Krasnow et al (U.S. Patent No. 6,493,431 B1), and further in view of Bose et al (US 2002/0042830 A1).

Referring to claim 1, Nguyen discloses an incoming message alarming system (abstract), comprising a wireless communication system for transmitting an incoming message to a called mobile communication terminal, and for transmitting a first notification message including an identification of a calling mobile communication terminal (paragraphs 7 and 8, “sending a data waiting message from the application server to a message center (MC)”), and

a messenger service system for receiving the first notification message from the wireless communication system and for sending a second notification message, the second message for providing notification of the incoming message (paragraph 7-8, “message center”, “notification”, “SMS”, “Data Waiting Indicator”, “the MC then sends a Short Message Service (SMS) message containing a Data Waiting Indicator”),

wherein the incoming message represents voice communications or data communications (abstract, paragraphs 4, and 6-8, “voice call”, “data”).

Nguyen does not specifically disclose sending messages to a personal computer.

In the same field of endeavor, Troen-Krasnow discloses sending incoming message alarming information indicating arrival of the incoming message to a personal computer (abstract, col. 1, line 60 through col. 2, line 2, and col. 5, lines 1-60, col. 6, lines 1-50, “server 180 then identifies the calling party based on the calling party’s telephone number”, “The notification message from the message server 180 may be an electronic mail (email) message

transmitted to the called party's personal computer over a computer network", "called party may log onto the message server 180 via network 400 to retrieve the message").

It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Nguyen by incorporating the teachings of Troen-Krasnow, and consequently providing sending incoming message notification to a personal computer of the called party, for the purpose of allowing the called party to receive and retrieve call alarm notifications and messages while logged on to a personal computer, and thus providing convenience to the user.

The combination of Nguyen/Troen-Krasnow does not specifically disclose providing real-time notification.

Bose discloses real-time message notification in his application of real-time messaging system for providing a real-time alert notification (abstract, paragraphs 51, 111, and 119, "real-time messaging system to provide for a real-time alert notification").

It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Nguyen/Troen-Krasnow by incorporating the teachings of Bose, and providing a real-time alert notification, for the purpose of letting the users know of any messages in real-time so that time sensitive messages, urgent, and emergency messages are processed in real time and consequently preventing potential problems that could arise from non-real-time notifications.

Referring to claims 8, 11 and 18, claims 8, 11 and 18 define a wireless communication system, a messenger service system, and a method for alarming an incoming message reciting features analogous to the message alarming system defined by claim 1 (as rejected above). Thus, the

combinations of Nguyen/Troen-Krasnow/Bose disclose all elements of claims 8, 11 and 18 (please see the rejection of claim 1 above).

Referring to claim 2, the combinations of Nguyen/Troen-Krasnow/Bose disclose the incoming message alarming system of claim 1, and further disclose the wireless communication system comprises a base station for receiving the incoming message, a mobile switching center for transmitting the first notification message to the messenger service system, and a home location register for storing location information of a called subscriber, subscriber information representing whether or not the called subscriber is an incoming message alarming service subscriber, and flag information indicating an activation state of the incoming message alarming service (Nguyen, figure 1-2, and paragraphs 8-10, and 21-27, 31 and 33, “BS-1”, “BS-2”, “MSC-1”, “MSC-2”, “HLR”, note that the subscriber is informed of the messages, hence a flag is inherently indicating the activation state of the incoming call, “notification”, “SMS”, “Data Waiting Indicator”). “HLR”, note that the HLR inherently comprises the database where the database has IP information about the subscribers in its domain).

Referring to claim 23, the combinations of Nguyen/Troen-Krasnow/Bose disclose the incoming message alarming system of claim 1, and further disclose the messenger service system comprises a messenger information database for storing an IP address and a messenger ID of a called subscriber corresponding to the called mobile communication terminal (Troen-Krasnow, Figures 1-5, col. 4, lines 29-41, col. 5, line 1-65, col. 6, lines 1-47, “the message server 180 receives the telephone call and reads the original called number, such as the Dialed Number Identification Service . . . to identify the called party (step 315), “the message server 180 sends a notification to the called party . . . to the called party’s personal computer”, “network 400 may

include an Internet", note the called party is identified according the number that was dialed, thus a messenger information database exists and stores the a messenger ID of the called party. Further, a message notification is sent to the called party's personal computer and through the Internet, hence it is inherent that IP address of the called party is found and used so that the notification message is sent to the called party's computer. Hence, it is inherent that messenger information database exists for storing IP address and a messenger ID of the called subscriber); and a messenger server for receiving the first notification message from the wireless communication system and for sending the second notification message, wherein the personal computer corresponds to the IP address (Troen-Krasnow, Figures 1-5, col. 4, lines 29-41, col. 5, line 1-65, col. 6, lines 1-47, note that a message notification is sent to the called party's personal computer and through the Internet, hence it is inherent a messenger server exists for receiving the base alarm information from the wireless communication system and sending the incoming message alarming information to the personal computer according to the IP address).

It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Nguyen by incorporating the teachings of Troen-Krasnow, and consequently providing the messenger service system to comprise a messenger information database for storing an IP address and a messenger ID of the called subscriber and a messenger server for receiving the base alarm information from the wireless communication system and sending the incoming message alarming information to the personal computer according to the IP address for the system of Nguyen, motivation being for the purpose of identifying the called party accurately through the Internet and sending notification via user's computer, and allowing

the called party to receive and retrieve notifications and messages while logged on to a personal computer, and providing convenience to the user.

Referring to claim 4, the combinations of Nguyen/Troen-Krasnow/Bose disclose the incoming message alarming system of claim 23, and further disclose the messenger server stores use information or whether to use an incoming message service alarming service in the messenger information database (Nguyen, figures 1-2, and paragraphs 8-10, and 21-23).

Referring to claims 9 and 14, the combination of Nguyen/Troen-Krasnow/Bose discloses the wireless communication system and the messenger service system of claims 8 and 11, and further disclose information in the first notification message is or the second notification message comprises an identification of the called mobile communication terminal and an identifications of a calling mobile communication terminal (see the rejection of claim 1).

Referring to claim 10, the combinations of Nguyen/Troen-Krasnow/Bose disclose the wireless communication system of claim 8, and further disclose the mobile switching center stores the first notification message (Nguyen, figures 1-2, and paragraphs 21-23).

Referring claim 12, the combination of Nguyen/Troen-Krasnow/Bose disclose the messenger service system of claim 11, and further disclose the second notificatio message is transmitted through the internet to the personal computer (Troen-Krasnow, col. 1, line 60 through col. 2, line 2, and col. 5, lines 1-60, col. 6, lines 1-50).

It would have been obvious to one of the ordinary skills in the art at the time of invention to modify the system of Nguyen by incorporating the teachings of Troen-Krasnow, motivation

being for the purpose of allowing the called party to receive and retrieve notifications and messages while logged on to a personal computer, and providing convenience to the user.

Referring to claim 13, the combination of Nguyen/Troen-Krasnow/Bose discloses the messenger service system of claim 11, and further disclose the messenger server stores the second notification message (Nguyen, paragraphs 7-10, and 21-23).

Referring to claim 19, the combination of Nguyen/Troen-Krasnow/Bose disclose the method of claim 18, and further disclose the step of transmitting a first notification message further comprises receiving the incoming message from a calling mobile communication terminal; and determining an activation state of an incoming message alarming service (Nguyen, paragraphs 7-10, and 21-24).

Referring to claim 21, the combination of Nguyen/Troen-Krasnow/Bose discloses the method of claim 19, and further disclose the step of transmitting a first notification message further comprises storing the first notification message (see rejection of claim 1).

Referring to claim 22, the combination of Nguyen/Troen-Krasnow/Bose discloses the method of claim 20, and further disclose storing the second notification message (Nguyen, paragraphs 7-10, and 21-23).

Referring to claim 24, the combinations of Nguyen/Troen-Krasnow/Bose disclose the system of claim 11 and further disclose the messenger server includes messenger server database (Nguyen, figures 1-4, col. 7-10, 16-19 and 21-24).

Referring to claims 25 and 26, the combinations of Nguyen/Troen-Krasnow/Bose disclose the systems of claims 9 and 14, and further disclose the first notification message or the

second notification message comprises a data message (Nguyen, abstract, paragraphs 7 and 8, rejection of claim 1)

Conclusion

14. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid, can be reached at (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER